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Application Number

09/705,559

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11/02/2000

First Named Inventor

Joseph A. McCluskey

Art Unit

3691

Examiner Name

Havan, Thu Thao

Attorney Docket Number

31083.048001

ENCLOSURES (Check all that apply)☐ Fee Transmittal Form☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/
Incomplete Application☐ Response to Missing Parts
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- return postcard**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

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Greenberg Traurig, LLP

Signature

Printed name

Gary R. Jarosik

Date

January 8, 2007

Reg. No.

35,906

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McCluskey et al.)
Serial No. 09/705,559) Examiner: Havan, Thu Thao
Filed: November 2, 2000) Art Unit: 3691
Title: System And Method For) Attny Docket: 31083.04US1
Electronically Sourcing)
Products)

SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby request reinstatement of the appeal and submit this Supplemental Appeal Brief to the Board of Patent Appeals and Interferences to respond to the Examiner's rejection of claims 1-16 which rejection was set forth in an Office Action mailed November 16, 2006.

This Supplemental Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of January, 2007.

By: Ranni Matar
Ranni Matar

I. Real Party In Interest

The real party in interest is W.W. Grainger, Inc.

II. Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status Of Claims

In the application claims 1-16 remain pending and having been at least twice rejected are the subject of this appeal.

The Section VIII Claims Appendix provides a clean, double spaced copy of pending claims 1-16.

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of Claimed Subject Matter

The subject matter defined in each of independent claims 1, 9, 11, 12, and 13 is generally directed to a system and/or method for providing product information to an on-line user.

More particularly, each of the independent claims defines a system and/or method which automates the finding of a source for a product that is specified in a search request but is not presently included within an electronic catalog. To this end, the system and/or method defined in each of the independent claims automatically finds a sourcing agent for the specified product and returns to the user information about the specified product when the specified product is found by the sourcing agent. Still further, the system and/or method defined in each of the

independent claims functions to update the electronic catalog using the information that is returned to the user.

By way of example with particular reference to Fig. 2; page 6, lines 15-25; page 8, lines 13-20; and page 9, lines 6-16 of the subject application, the invention defined in each of the independent claims provides product information to an on-line user by first presenting to a user a Web page or the like that allows a user to initiate an electronic search for a product within an electronic catalog. Generally, a request for product information includes one or more product identifiers. In the event that the electronic catalog has listed therein any products that correspond to the product identifier(s) entered by the user the product information for the matching product(s) is extracted from the electronic catalog and returned to the user by the system. If, however, the system determines that the electronic catalog does not contain information for the requested product(s), the system compares information within the request against a set of predetermined rules to determine a sourcing agent to which the electronic request is to be routed and the system then functions to automatically route the request to that sourcing agent. In this manner, the claimed system and method has the advantage of automatically ensuring that the request is routed to a sourcing agent that specializes in finding sources for the product type specified by the user. Product information retrieved by the sourcing agent is then transparently returned to the user so that it appears to the user as if the requested product(s) were in the electronic catalog all along. The product information may also be manually or automatically entered into the electronic catalog to thereby keep current the electronic catalog.

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection of claims 1-16 under 35 U.S.C. § 103 can be maintained when Talib (U.S. Published Application No. 2001/0044758) and Singh (U.S. Published Application No. 2001/0047311), whether considered alone or in combination, fail to disclose each and every element, considering each and every word, set forth in the claims.

2. Whether the rejection of claims 1-16 under 35 U.S.C. § 103 can be maintained when the modification of Talib espoused within the rejection of the claims would change the principle of operation of Talib.

VII. Argument

A. Summary Of The Rejection

Pending claims 1-16 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Talib as modified by Singh.

In rejecting the claims it was asserted that Talib discloses a system for providing a customer with information regarding a product which receives an electronic request for information for a product, which searches an electronic database to determine if the electronic database contains information for the product, and which sends an electronic message to the customer containing selected information from the electronic database that corresponds to the product in the event that the electronic database contains information for the product.

Inexplicably, the rejection of the claims then asserts that Talib also discloses that, if the electronic database does not contain information for the product requested by the customer, the system of Talib automatically sends an electronic request to a sourcing agent to gather information for the product which gathered information is returned to the customer in an

electronic message as well as added to the electronic database while then seemingly acknowledging that Talib does not disclose any of these claimed elements, i.e., by noting that Talib does not even teach searching outside of the electronic database in the first instance. Nevertheless, the rejection of the claims continues by asserting that Singh discloses searching outside of an electronic database and concludes that it would have been obvious to modify the system of Talib using the teachings of Singh to implement a search outside of the electronic database to gather additional information in a collaborative market for products and services via a communication network.

B. Applicable Law

It is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose each and every element set forth in the claims, *considering each and every word*. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references and combined them in the claimed manner.

It is further respectfully submitted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination. See In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Similarly, a statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Yet further, a proposed combination of the prior art that would have all of the claim elements fails to have the requisite teachings or suggestions when the proposed combination would change the principle of operation of the prior art invention being modified. In such a case the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

C. Talib and/or Singh Fail To Disclose Each And Every Element Claimed

Considering first Talib, Talib is directed to a system for searching an electronic catalog that solves, among others, the problem of user frustration associated with a user searching for a product that does not exist within the product database (Para. 29, lines 1-4). To solve this problem, Talib only allows a user to search for products that are already within the product database and which have been tagged with various taxonomy labels. In this manner, when a user enters a search query, the system of Talib presents to the user taxonomy categories relevant to the search term and the user may then select from only those presented taxonomy categories to further refine their search. By “pushing data back to the user,” the system of Talib never presents invalid, zero-member categories and, therefore, is designed specifically and expressly to

prevent a user from specifying a product that does not already exist within the electronic catalog taxonomy. (Figs. 10 and 11; and Paras. 120-146).

When Talib is considered in its entirety, it is evident that, by preventing a user from “defining a product that does not exist” within the electronic catalog, the system of Talib, *by its express design*, will always return to a customer information for a product that already exists within the electronic catalog when a search is performed. Since product information for products that already exist within the electronic catalog is always returned when a search is performed using the system of Talib, *an instance never arises in Talib where the electronic database fails to contain information for the product being requested.* Thus, contrary to the position taken in the rejection of the claims and later seemingly acknowledged by the Examiner, the system of Talib can never determine that “the electronic database does not contain information for a product,” and, as such, the system of Talib never “performs a search outside of the electronic database to gather information for the product [requested but not in the database] which gathered information is returned to the customer in an electronic message and added to the electronic database” and certainly never uses product descriptors to determine “if a product does not exist” in the catalog (since the product always exists in the catalog of Talib) let alone “to determine a sourcing agent to which an electronic request is to be routed in the event that the electronic database does not contain information for a product.”

Turning now to Singh, Singh discloses a system in which buyers can request price quotes from suppliers by using a communications network. To this end, a supplier posts or sends a request to a web server for price quotes including precise specifications for items desired. Suppliers can then view requests by accessing a web site and respond with price quotes. Furthermore, the web server can automatically send requests for price quotes to suppliers by

email, pagers, etc. based on purchase orders posted there by potential buyers. (Para. 0026). For this purpose, the web server has an application program and a search engine for matching a list of registered suppliers with specifications provided by buyers. (Para. 0032). Thus, like Talib, it will be appreciated that Singh never discloses, teaches, or suggests the desirability of using product descriptors to determine if a product can or cannot be found within an electronic catalog and, if the product cannot be found within the electronic catalog, *then* further using a set of predetermined rules to determine a sourcing agent to which an electronic request is to be routed, returning information for the product that could not found within the electronic catalog to the customer, and adding the information gathered outside of the electronic catalog to the electronic catalog as is claimed.

From the foregoing it is respectfully submitted that neither Talib nor Singh, whether considered alone or in combination, can be said to disclose each and every element recited in the claims particularly when the claims are considered in their entirety as is required. For example, it has been demonstrated that neither Talib nor Singh disclose, teach, or suggest the desirability of a system/method which first determines if a requested product is within an electronic catalog and which then functions, if the requested product is not within the electronic catalog, to gather information for the requested product from a source outside of the electronic catalog which gathered information is then returned to the customer and used to update the electronic catalog. Therefore, since Talib fails to disclose that which has been relied upon in the rejection of the claims and since Singh fails to disclose teach or suggest those elements that are missing from Talib, e.g., a system which determines if an electronic database does not contain information for the product requested by the customer and, if not, which automatically sends an electronic request to a sourcing agent to gather information for the product which gathered information is

returned to the customer in an electronic message and added to the electronic database, it is respectfully submitted that the combination of Talib and Singh fails to present a *prima facie* case of obviousness and the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

D. The Proposed Modification Changes The Principle Of Operation Of Talib

When the teachings of Talib are fully and fairly considered in their entirety, it will be appreciated that the modification of Talib espoused in the rejection of the claims would impermissibly change the principle of operation of Talib. In this regard, the goal of the system of Talib is to provide a “closed system,” i.e., a system in which all searching is limited to a stringent taxonomy which is utilized to categorize all possible search results. To achieve this goal, Talib’s system operates on the principle of limiting the searching abilities of a user by presenting to the user only taxonomies of products already within the electronic catalog. In this manner, the user is never frustrated by a request to find a product that does not already exist within the electronic catalog. Meanwhile, the Examiner proposes to modify Talib to provide for searching outside of the electronic database. Since it is evident that this espoused modification would impermissibly change the principle of operation of Talib from a “closed system” to an “open system,” i.e., one that would encompass searching outside of the stringent taxonomy required by Talib, it is respectfully submitted that the espoused modification is not sufficient to render the claims *prima facie* obvious and the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

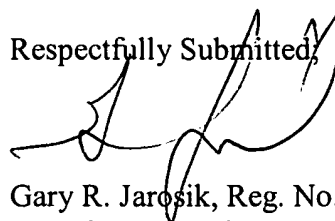
E. Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are not rendered obvious by the combination of references set forth in the Office Action. As

such, it is respectfully submitted that the application is in good and proper form for allowance.

Such action of the part of the Board is respectfully requested.

Respectfully Submitted,

A handwritten signature in black ink, appearing to be 'G. Jarosik', written over the words 'Respectfully Submitted,'.

Date: January 8, 2007

By: Gary R. Jarosik, Reg. No. 35,906
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VIII. Claims Appendix

The following is a copy of the claims involved in the appeal:

1. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;
searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database that corresponds to the product; and

if the electronic database does not contain information for the product, automatically sending an electronic request to a sourcing agent to perform a search outside of the electronic database to gather information for the product which gathered information is returned to the customer in an electronic message and added to the electronic database.

2. The method as recited in claim 1, wherein requesting a sourcing agent to perform a search comprises forwarding the electronic request to the sourcing agent as a request for quotation.

3. The method as recited in claim 2, wherein the request for quotation is prepared by the customer in response to a prompt that is automatically sent to the customer when the electronic database does not contain information for the product.

4. The method as recited in claim 1, wherein the electronic request is received via the Internet.

5. The method as recited in claim 1, wherein the electronic request is forwarded to the sourcing agent via an email.

6. The method as recited in claim 1, comprising comparing the electronic request against a set of predetermined rules to determine the sourcing agent to which the electronic request is to be routed; and automatically routing the electronic request to the sourcing agent determined to be appropriate by the step of comparing, the sourcing agent performing a search to find a source for the product specified in the electronic request.

7. The method as recited in claim 6, wherein the step of comparing comprises comparing words in the electronic request against a set of predetermined product descriptors to determine a type of product specified in the request.

8. The method as recited in claim 6, further comprising the step of preparing an email that includes information representative of the electronic request.

9. A computer-readable medium having instruction for sourcing a product, the instructions performing steps comprising:

receiving an electronic request specifying a product;

searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to a message recipient containing selected information from the electronic database that corresponds to the product; and

if the electronic database does not contain information for the product, automatically comparing the electronic request against a set of predetermined rules to determine a sourcing agent to which the electronic request is to be routed; routing the electronic request to the sourcing agent determined to be appropriate by the step of comparing where the sourcing agent performs a search outside of the electronic database to find a source for the product specified in the request; receiving an electronic message from the sourcing agent including information for the product from the source; and automatically updating the electronic database with the information for the product from the source.

10. The computer-readable medium as recited in claim 9, wherein the instructions perform the further step of sending the source for the product specified in the request as determined by the sourcing agent to an originator of the request.

11. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;
searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database corresponding to the product; and

if the electronic database does not contain information for the product, performing a search outside of the electronic database to gather information for the product, sending the gathered information in an electronic message to the customer, and adding the gathered information to the electronic database.

12. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;

searching an electronic database to determine if the database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database corresponding to the specified product; and

if the electronic database does not contain information for the product, providing the customer with an option to authorize a further search outside of the electronic database to gather information for the product which, if authorized, causes the performing of the further search, the returning to the customer in an electronic message the gathered information, and the adding of the gathered information to the electronic database.

13. An electronic commerce system, comprising:
an electronic catalog having product information;
a first component that accepts an electronic request for quotation for a product not contained within the electronic catalog, the first component automatically routing the request for quotation to a sourcing agent determined by the first component to be appropriate for finding a source for the product not contained within the electronic catalog; and
a second component that allows a user to search the electronic catalog to gather information for a selected product and that automatically provides access to the first component if the electronic catalog does not contain information pertaining to the selected product.
14. The system as recited in claim 13, wherein the electronic catalog and second component reside on a Web server of a third party vendor.
15. The system as recited in claim 13, further comprising a portal through which the electronic catalog, first component and second component are accessible.
16. The system as recited in claim 13, wherein the electronic catalog, first component and second component reside on a single Web server.

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IX. Evidence Appendix

No evidence has been submitted pursuant to Secs. 1.130, 1.131, or 1.132 and no additional evidence is being relied upon in this appeal.

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X. Related Proceedings Appendix

No decisions rendered by a court or the Board related to this appeal exist for submission.

CHI 56630052v1